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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/614,586

07/12/2000

Gilles Elliot

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7590

04/28/2004

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EXAMINER

CIRIC, LJILJANA V

ART UNIT

PAPER NUMBER

3753

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/614,586

Applicant(s)

ELLIOT ET AL.

Examiner

Ljiljana (Lil) V. Ciric

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May, 25 June, & 7 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 and 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-10,17-23,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendments and arguments filed on May 15, 2003, June 25, 2003, and October 7, 2003.
2. Claims 1 through 23, 30, and 31 remain in the application. Of these, claims 30 and 31 are new, whereas the remaining claims are as amended, either directly or indirectly. Claims 3 through 6 and 11 through 16 are withdrawn from consideration as noted in greater detail below.

Response to Arguments

3. Applicant's arguments filed on May 15, 2003, June 25, 2003, and October 7, 2003 have been fully considered but they are not persuasive.

In response to applicant's arguments filed on May 15, 2003 that the Wolf reference has "no requirement for the coolant plus water plus air elements as set forth in the present invention", the examiner notes that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." See *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *See In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

In response to applicant's argument that the Wolf reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the "condenser tubes and radiator tubes have to be in contact") are not recited in the rejected claim(s), and most particular not in independent base claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Applicant then goes on to argue in the reply filed on June 25, 2003 that the apparatus of the Wolf reference and the claimed invention function differently. In response, the examiner notes that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Also, “[A]pparatus claims cover what a device *is*, not what a device *does*. (Emphasis in original). Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Applicant furthermore argues that “when there is circulation in Wolf system [sic], the air stays normally outside the vehicle.” Although this particular argument is not clearly understood, the examiner notes in reply that Wolf clearly discloses an internal air circulation system including a duct system 50 associated with the vehicular a/c system.

The reply filed on October 7, 2003 does not add any significantly different arguments to the ones addressed above.

As a further note, the examiner wishes to note that language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure *does not limit the scope of a claim or claim limitation*. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

This list of examples is not intended to be exhaustive. See MPEP 2106. The applicant in the instant application appears to try to rely significantly on exactly the above types of optional language for patentability.

Applicant is furthermore respectfully reminded that claims in a pending application should be

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given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Applicant's arguments as a whole thus fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments as a whole also thus do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Election/Restrictions

4. Claims 3 through 6 and 11 through 16 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to the non-elected second through sixth species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6. Of these withdrawn claims, claim 11 is newly withdrawn from consideration because, upon reconsideration in view of the clarifying amendments to claim 11 made via the reply filed on May 15, 2003, it became clearer that claim 11 is readable on the non-elected third through sixth species as described on pages 15 through 17 of the originally filed specification.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s): the drawings (and especially Figures 1a-d readable on the elected species) fail to show "a heat dissipating fin adjacent said second circulated element" as now recited in new claim 31.

No new matter should be entered to the drawings.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The amendment filed on May 15, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the original disclosure fails to support the recitation of "a heat dissipating fin adjacent said second circulated element" appearing in new claim 31.

Applicant is ***required*** to cancel the new matter in the reply to this Office Action.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Currently, there appears to be no antecedent basis in the specification for a heat dissipating fin as now recited in newly added claim 31.

Claim Rejections - 35 U.S.C. § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure fails to provide any support for "a heat dissipating fin adjacent said second circulation element" having refrigerant flow therethrough (especially associated with the embodiment of the elected species) as now claimed in new claim 31. The aforementioned limitations thus represent new matter.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claims 1, 2, 7 through 10, 17 through 23, 30, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are still generally narrative and indefinite, written in run-on fashion with at least some grammatical/idiomatic informalities, and failing to conform with current U.S. practice.

With regard to claim 9 as amended, it is not clear whether the “*exchanger* element” as first recited in line 1 of the claim refers to an element of the main fluid-carrying heat exchanger or to an element of some other part of the installation, thus rendering indefinite the metes and bounds of protection sought by claim 9 and claim 10 depending therefrom.

The limitations “wherein circulation of the refrigerant fluid and circulation of the heat-carrying fluid currents are at least *partly opposite* to each other” as recited in claim 10 are not clear as written, thus further rendering claim 10 indefinite.

The limitations following “wherein” in each of claims 17 and 18 are also still not readily comprehensible as written, thereby rendering these claims, along with claim 19 depending from claim 18, indefinite with regard to the scope of protection sought. For example, claim 17 recites “a second routing circuit”, implying that there should also be “a first routing circuit”, but no such routing circuit appears to be recited in either claim 17 or in claim 1 from which claim 17 depends. Also with regard to claim 17 as written, the limitations “the heat pump utilizing the condenser of the main fluid-carrying heat exchanger and the additional evaporator as an apparatus for converting liquid into vapor” are particularly unclear. For example, which liquid does the apparatus convert into vapor? It is furthermore not clear whether various elements recited as part of these limitations in each of claims 17 and 18 are or are not intended to be positively recited.

Claim 20 recites "at least one of cooling water and overcooled water". Claim 21 depends from claim 20 and refers to both "said overcooled water" and to "said cooling water", but claim 20 as written does not guarantee proper antecedent basis for both of these limitations as recited in claim 21.

With regard to claim 30 as written, it is not clear which particular structures are encompassed by the limitations "a first circulation element" and "a second circulation element" as recited in the claim.

Claims 1, 2, 7 through 10, 17 through 23, 30, and 31 are still rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are, *for example*: the ones between the refrigerating compressor, the pressure-reducing valve, the evaporator, and the main fluid-carrying heat exchanger as recited in claim 1; the ones between the additional evaporator, the second routing circuit, and the heat pump as recited in claim 17; the ones between the routing circuit and the heating loop as recited in claim 18; and, the ones between the mixing flap and the main fluid-carrying heat exchanger.

The above is a comprehensive and generally indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

Claim Rejections - 35 U.S.C. § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. As best can be understood in view of the indefiniteness of the claims, claims 1, 2, 7 through 10, 18 through 20, 30, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by *Wolf*.

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Wolf discloses a vehicular heating/air conditioning installation essentially as claimed, including, for example: a refrigerating compressor 32, a pressure reducing valve 44, an evaporator 46, and a combined heat exchanger 10 comprising a gas cooler/condenser section 30 and a heating element/radiator section 25 grouped together into a single heat exchanger or module 10, where the pressure reducing valve 44 is arranged downstream of the heat exchanger 10. The single heat exchanger or module 10 includes two collectors 20 and 26 arranged at opposite ends of the heat exchanger 10, and also includes the various heat transfer surfaces as cited in claims 2 and 7 of the instant application [see Fig. 4 and Fig. 7 of *Wolf*].

The reference thus reads on the claims.

14. The non-application of art against claims 17 and 21 through 23 should not be construed as an indication that the claims contain allowable subject matter but rather that the claims could not be examined on the merits due to indefiniteness.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Frugier et al., filed on July 12, 2000, does not constitute prior art per se, but it is of interest because it does share both a common inventor (Gilles Elliot) and a common assignee (Valeo Climatisation) with the instant application, and also because it teaches having plural elements of a vehicular air conditioner within a single casing. Valeo Climatisation (JP 2001-191786A), published on July 17, 2001 and filed on December 11, 2000, similarly does not constitute prior art per se, but it is of interest because it also shares both a common inventor (Ben Mounir Fredj) and a common assignee (Valeo Climatisation) with the instant application, and also because it too teaches arranging several elements of a vehicular air conditioner within a single module. In view of these related cited hereby by the examiner, applicant is respectfully reminded of the duty to disclose.

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16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

April 24, 2004


LJILJANA V. CIRIC
PRIMARY EXAMINER
ART UNIT 3753